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EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,019

Applicant(s)

BARRUS ET AL.

Examiner

Matthew J. Ludwig

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-13, 16-21, 24, 26-35, 37, 39 and 41-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-13, 16-21, 24, 26-35, 37, 39, and 41-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/31/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This document is a Non-Final Office Action on the merits. This action is responsive to the following communications: Request for Continued Examination, which was filed on 10/20/07.
2. Claims 3-13, 16-21, 24, 26-35, 37, 39, 41-67 are currently pending in the case, with claims 1, 4, 18, 33, 41, 56, 57, 59, 62, 63, and 64 being the independent claims.
3. Claims 1, 2, 14, 15, 22, 23, 25, 36, 38, 40, are cancelled.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 3-7, 11, 12, 16, and 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier, et al., USPN 5,870,552 filed (2/9/1999) in view of Bell et al., US Patent Pub. US 2003/0130952 filed (1/9/2002).**

Regarding **independent claim 3, as amended**, Dozier teaches:

*A method of composing a collection of information comprising:
receiving a plurality of documents in an order;*

*determining the order of the plurality of paper documents;
performing at least one action to cause a change to a stored document
collection, wherein
the at least one action is selected responsive to the order of the
documents.*

(See, Dozier, Figure 7, and col. 3, line 41 through col. 4, line 43, teaching the input and storage and manipulation of electronic documents and that the documents may be ordered.)

The reference fails to explicitly state the retrieval of paper document in an order, however, the Bell reference discloses a method for submitting paper documents using a printer/scanner which scans the electronic paper interface and document into an electronic format. This information is submitted to enhanced barcode server. The content is appropriately stored in the electronic market by storing the digitized interface subject matter into rights database and the content into merchandise database of the server system hosting electronic market (compare to "***receiving a plurality of paper documents in an order and performing at least one action to cause a change to a stored document collection responsive to the order of the documents***"). See page 6, [0071]. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dozier and Bell before them at the time the invention was made, to modify the document authoring methods taught by Dozier to include the scanning methods of Bell, because it would have provided an additional way to add document to the collection and browse document collections.

Regarding **independent claim 4**, Dozier teaches:

A method of composing a collection of information comprising:
receiving a first document;
receiving at least one subsequent document;
determining whether the first document includes an indicium identifying a
collection;
responsive to the determination, selecting among the actions of:
adding the at least one subsequent document to the collection
identified by the indicium; and
creating a new collection; and
performing the selected action.

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the documents to an existing or new collection.) The reference fails to explicitly state the retrieval of paper document in an order, however, the Bell reference discloses a method for submitting paper documents using a printer/scanner which scans the electronic paper interface and document into an electronic format. This information is submitted to enhanced barcode server. The content is appropriately stored in the electronic market by storing the digitized interface subject matter into rights database and the content into

merchandise database of the server system hosting electronic market (compare to "receiving a plurality of paper documents in an order and performing at least one action to cause a change to a stored document collection responsive to the order of the documents"). See page 6, [0071]. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dozier and Bell before them at the time the invention was made, to modify the document authoring methods taught by Dozier to include the scanning methods of Bell, because it would have provided an additional way to add document to the collection and browse document collections.

Regarding **dependent claim 5**, Dozier teaches:

The method of claim 4, wherein the action of creating a new collection further comprises adding the at least one subsequent document to the new collection.

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the documents to an existing or new collection.)

Regarding **dependent claim 6**, Dozier teaches:

The method of claim 4, wherein selecting the action comprises:

responsive to the first document including an indicium identifying a collection, selecting the action of adding the at least one subsequent document to the collection identified by the indicium.

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the documents to an existing or new collection.)

Regarding **dependent claim 7**, Dozier teaches:

*The method of claim 4, wherein selecting the action comprises:
responsive to the first document not including an indicium identifying a collection, selecting the action of creating a new collection.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, and generating a new collection by associating the documents together, with the selected action being a new collection.)

Regarding **dependent claim 11**, Dozier teaches:

*The method of claim 4, further comprising:
responsive to the first document including an indicium identifying a first collection, and a subsequent document including an indicium identifying a*

second collection, adding at least a subset of the contents of the second collection to the first collection.

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the all or part of the documents to an existing or new collection.)

Regarding **dependent claim 12**, Dozier teaches:

The method of claim 4, further comprising:

responsive to the first document including an indicium identifying a first collection, and a subsequent document including an indicium identifying a second collection, adding the second collection as a subcollection of the first collection.

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the all or part of the documents to an existing or new collection.)

Regarding **dependent claim 16**, Dozier teaches:

The method of claim 4, wherein each collection comprises at least one multimedia item.

(See, Dozier, Figure 7, teaching the inclusion of a "gif" file, a multimedia file typically a graphic, in a document collection along with "htm," "stl," "nvm," and text documents. See also, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the all or part of the documents to an existing or new collection.

It is noted that the application does not define the term "multimedia." Accordingly, it will read as was known to a person of ordinary skill in the art at the time of the invention, as defined in "Microsoft Computer Dictionary," Fifth Edition, 2002, Microsoft Press, as follows: "The combination of sound, graphics, animation, and video. In the world of computers, multimedia is a subset of hypermedia, which combines the aforementioned elements with hypertext."

There is no limitation in Dozier to the number of times a multimedia item may be included in a collection, and, upon teaching that a multimedia item may be included in one collection, without further limitation, it is inherent that a multimedia item may be included in all collections.)

Regarding **dependent claim 17**, Dozier teaches:

The method of claim 4, wherein each collection comprises at least one item selected from the group consisting of:

documents;

images;

files;

video data; and

audio data.

(See, Dozier, col. 4, lines 6-10, teaching the linking of hypermedia. See also, Dozier, col. 3, line 41 through col. 4, line 43, teaching collections of documents.)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 18-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, et al., (U.S. Patent 6,009,442, issued December 28, 1999) [hereinafter "Chen"] in view of Bell et al., Pat. Pub. US 2003/0130952 A1 filed (1/9/2002).**

Regarding **independent claim 18**, Chen teaches:

*A method for adding an annotation to a collection of information,
comprising:
receiving an annotated media item identifying the collection of information;
reading the annotation from the media item; and
adding the annotation to the collection of information.*

(See, Chen, col. 3, line 37 through col. 4, line 61, teaching a document collection. See also, Chen, col. 18, lines 42-55, teaching an annotations utility that receives annotated media, reads the annotation and adds annotations to the collection of documents.)

The reference fails to explicitly state the retrieval of a paper document, however, the Bell reference discloses a method for submitting paper documents using a printer/scanner which scans the electronic paper interface and document into an electronic format. This information is submitted to enhanced barcode server. The content is appropriately stored in the electronic market by storing the digitized interface subject matter into rights database and the content into merchandise database of the server system hosting electronic market (compare to “the media item comprising a piece of paper”). See page 6, [0071]. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Chen and Bell before them at the time the invention was made, to modify the document annotation methods taught by Chen to include the scanning methods of Bell, because it would have provided an additional way to add documents to the collection and browse document collections based upon an annotated media item.

Regarding **dependent claim 19**, Chen teaches:

*The method of claim 18, wherein adding the annotation comprises:
retrieving, from a storage device, the identified collection;
modifying the retrieved collection to add the annotation; and
storing the modified collection.*

(See, Chen, col. 5, line 51 through col. 6, line 12, teaching storage of the documents and collections. See also, Chen, col. 3, line 37 through col. 4, line 61, teaching a document collection. See also, Chen, col. 18, lines 42-55, teaching an annotations utility that receives annotated media, reads the annotation and adds annotations to the collection of documents.)

Regarding **dependent claim 20**, Chen teaches:

*The method of claim 18, wherein the collection of information comprises a
collection of multimedia documents.*

(See, Chen, col. 4, lines 12-19, teaching that documents of various types may be stored, including multimedia documents, e.g., JPEG.)

Regarding **dependent claim 21**, Chen teaches:

*The method of claim 18, wherein receiving the annotated media item
comprises scanning the item.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner.)

Regarding **dependent claim 24**, Chen teaches:

The method of claim 18, wherein the annotation is handwritten.

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. It is inherent in scanning that any handwritten annotation will be scanned in with the rest of the document.)

Regarding **dependent claim 25**, Chen teaches:

The method of claim 18, wherein receiving an annotated media item comprises receiving a paper document.

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner.)

Regarding **dependent claim 26**, Chen teaches:

The method of claim 18, wherein receiving an annotated media item comprises receiving a collection coversheet.

(See, Chen, col. 18, line 56 through col. 19, line 44, teaching a coversheet associated with documents and document collections.)

Regarding **dependent claim 27**, Chen teaches:

The method of claim 18, wherein the annotated media item further comprises a pointer to the collection.

(See, Chen, col. 1, line 64 through col. 2, line 42, teaching that summaries of documents are kept in a separate but associated file. See also, Chen, col. 5, line 52 through col. 9, line 53, teaching the use of pointers to associated files, including collections.)

Claims Rejection – 35 U.S.C. 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 8-10, 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier, et al. (U.S. Patent 5,870,552, issued February 9, 1999) [hereinafter "Dozier"].**

Regarding **dependent claim 8**, Dozier teaches:

The method of claim 4, further comprising:

for at least one of the subsequent documents, receiving a separator prior to receiving the document.

(Dozier teaches the association of a series of documents in a sequential order.

Dozier does not expressly teach a "separator."

A separator is disclosed by the Applicants as follows: *"A separator page 2601, an example of which is shown in FIG. 7, can be used to denote the end of one document 104 and the beginning of a new document 104. MFP 100 detects separator page 2601 and, thereby recognizes that a new document 104 is about to begin. Separator page 2601 makes it possible for the user to queue several documents for MFP 100 to scan in one stack. In one embodiment, separator page 2601 is an easily produced sheet of paper with a printed machine-readable indicator such as a barcode 2602. Separator page 2601 may be similarly formatted as a collection coversheet. Alternatively, separator page 2601 may be any kind of separator identifiable by MFP 100."* Disclosure, paragraph [0093].

The "separator" of the instant application is merely a document in Dozier, which may be placed between other documents according to the teachings of Dozier. The function of the document is the same whether it is called a "separator" or whether it is named anything else.

The differences between Dozier and a "separator" is only found in the nonfunctional descriptive material and does not alter how the invention functions. Thus, the descriptive material will not distinguish the claimed invention for the prior art in terms of patentability. See, *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to place a document between to other documents because the name of the document is non-functional and any document will perform the same

function.)

Regarding **dependent claim 9, as amended**, Dozier teaches:

The method of claim 8, wherein the separator comprises a piece of paper including a separator indicium.

(Dozier teaches the association of a series of documents in a sequential order.

Dozier does not expressly teach a “separator comprising a piece of pager including a separator indicium.”

A separator is disclosed by the Applicants as follows: “A *separator page 2601, an example of which is shown in FIG. 7, can be used to denote the end of one document 104 and the beginning of a new document 104. MFP 100 detects separator page 2601 and, thereby recognizes that a new document 104 is about to begin. Separator page 2601 makes it possible for the user to queue several documents for MFP 100 to scan in one stack. In one embodiment, separator page 2601 is an easily produced sheet of paper with a printed machine-readable indicator such as a barcode 2602. Separator page 2601 may be similarly formatted as a collection coversheet. Alternatively, separator page 2601 may be any kind of separator identifiable by MFP 100.*” Disclosure, paragraph [0093].

The “separator” of the instant claim is a piece of paper which is entered into the computer system as a document and is merely a document in Dozier, which may be placed between other documents according to the teachings of Dozier. The function of the document is the same whether it originates as a piece of paper before being entered

into the computer and is called a "separator" or whether it enters the computer in any other manner and is named anything else.

The differences between Dozier and a "separator" is only found in the nonfunctional descriptive material and does not alter how the invention functions. Thus, the descriptive material will not distinguish the claimed invention for the prior art in terms of patentability. See, *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to place a piece of paper as a separate document between to other documents and to enter them as separate documents into the computer because the origin and name of the document is non-functional and any document will perform the same function.)

Regarding **dependent claim 10**, Dozier teaches:

The method of claim 4, wherein each document comprises at least one piece of paper, and wherein receiving the document comprises scanning the at least one piece of paper.

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching the invention of claim 4. Dozier does not expressly teach that each document comprises at least one piece of paper, and wherein receiving the document comprises scanning the at least one piece of paper.

The Examiner takes official notice of the fact that method steps that are performed by computer include the manipulation of data that is inputted to the computer by well known prior art means including scanning a document into a computer memory. It would have been obvious to a person of ordinary skill in the art at the time of the invention to scan a document into the computer for purposes of saving time over re-typing the document or for purposes of inputting graphics or other data.)

Regarding **dependent claim 13**, Dozier teaches:

The method of claim 4, wherein:

receiving a first document comprises scanning a piece of paper; and

receiving at least one subsequent document comprises scanning at least one piece of paper.

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching the invention of claim 4.

Dozier does not expressly teach that receiving a first document comprises scanning a piece of paper and receiving at least one subsequent document comprises scanning at least one piece of paper.

The Examiner takes official notice of the fact that method steps that are performed by computer include the manipulation of data that is inputted to the computer by well known prior art means including scanning a document into a computer memory. It would have been obvious to a person of ordinary skill in the art at the time of the invention to scan a document into the computer for purposes of saving time over re-typing the document or for purposes of inputting graphics or other data.)

Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, et al., (U.S. Patent 6,009,442, issued December 28, 1999) [hereinafter "Chen"].

Regarding **dependent claim 23**, Chen teaches:

The method of claim 18, wherein receiving the annotated media item comprises receiving a fax transmission including the item.

(See, Chen, col. 3, lines 47-59 and col. 9, lines 55-61, teaching that documents may be received from various sources, including from a local area network [LAN], or from the internet. Chen does not expressly teach the receipt of documents through fax transmission.

The Examiner takes official notice of the fact that method steps of receiving documents into a computer from "various sources," including a LAN and the internet, includes receipt of documents through well known prior art means including via fax transmission. It would have been obvious to a person of ordinary skill in the art at the time of the invention to input documents to a computer using fax transmission for purposes of rapid and accurate inputting of graphics or other data.)

Regarding **dependent claim 28**, Chen teaches:

The method of claim 18, wherein reading the annotation from the media item comprises scanning an annotation region of the media item.

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. Chen does not expressly teach scanning only the region of the media item with an annotation.

The Examiner takes official notice of the fact that method steps of scanning a document into a file were at the time of the invention well known to included the ability to limit the range of the scan at the discretion of the user. It was well known by a person of ordinary skill in the art at the time of the invention that a scan of a document could comprise a scan of a mere portion of the document for purposes of efficiency in scanning time and memory usage as well as to focus the material scanned into the computer to a smaller region such as a graphic, a picture, or a portion of a text as compared to the whole of a document.)

Regarding **dependent claim 29**, Chen teaches:

The method of claim 18, wherein reading the annotation from the media item comprises performing optical character recognition on at least a portion of the media item.

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. Chen does not expressly teach performing optical character recognition on at least a portion of the media item.

The Examiner takes official notice of the fact that method steps of scanning a document into a file were at the time of the invention well known to included the ability to perform an optical character recognition (OCR) function at the discretion of the user.

It was well known by a person of ordinary skill in the art at the time of the invention that a scan of a document could include OCR conversion of text for purposes of efficiency and speed in entering text data.)

Regarding **dependent claim 30, as amended**, Chen teaches:

The method of claim 18, wherein reading the annotation from the media item comprises:

*scanning at least a portion of the media item to obtain an image; and
removing preprinted marks from the image.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. Chen does not expressly teach removing preprinted marks from an image.

The Examiner takes official notice of the fact that method steps of scanning a document into a file were at the time of the invention well known to included the ability to edit or otherwise modify the image of the scan at the discretion of the user. It was well known by a person of ordinary skill in the art at the time of the invention that a scan of a document could include editing and document modification features of a scanned document for purposes of cleaning up, cropping, or artfully modifying a document, etc.)

Regarding **dependent claim 31**, Chen teaches:

The method of claim 30, wherein the preprinted marks comprise lines.

(Claim 31 incorporates substantially similar subject matter as claimed in claim 30, and is rejected along the same rationale.)

Regarding **dependent claim 32**, Chen teaches:

The method of claim 18, wherein reading the annotation from the media item comprises:
retrieving a previously stored media item; and
extracting differences between the previously stored media item with the received annotated media item.

(Chen teaches the invention of claim 18. Chen does not teach comparing a new document with a stored document.

The Examiner takes official notice of the fact that method steps of adding a document into a file were at the time of the invention well known to included the ability to compare two documents at the discretion of the user. It was well known by a person of ordinary skill in the art at the time of the invention that any two documents may be compared to each other for purposes of reflecting edits, discovering differences, identification of documents, etc.)

10. Claims 33-37, 39, and 41-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier, et al. (U.S. Patent 5,870,552, issued February 9, 1999) [hereinafter "Dozier"] as applied to claims 1-7, 11, 12, 16, and 17 above, in view of MacPhail, (U.S. Patent 5,280,609, issued January 18, 1994) [hereinafter

“MacPhail”] and further in view of Bergen, (U.S. Patent 5,710,874, issued January 20, 1998) [hereinafter “Bergen”].

Regarding independent claim 33, as amended, Dozier in view of MacPhail and further in view of Bergen teaches:

A method of providing differentiated access to a collection of information, the method comprising:

generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels;

generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level; and

outputting a representation of at least one of the pointers.

(It is noted that the application discloses a “pointer” as follows: “Each collection has a specific, unique address or identifier, such as a uniform resource locator (URL), which provides a pointer to the collection. References herein to a pointer, collection identifier, or distributed resource identifier (DRI) can be considered to refer to a URL or any other mechanism, tag, handle, pointer, or technique for identifying a file, collection, directory, or other group of files.” See, disclosure, paragraph [0053].

Dozier teaches a method of providing differentiated access to a collection of information, but does not expressly teach a pointer to a collection of information specifying a first access level from a plurality of access levels.

MacPhail teaches a pointer, or "LADN entry," to a security level associated with a document for the purpose of restricting access and users of the document. See, MacPhail, col. 4, lines 4-65, teaching the pointer and security levels.

Dozier and MacPhail are combinable because they both involve access to documents scanned or otherwise incorporated into an electronic form, with Dozier teaching multiple documents in files and security associated with access to those files, and with MacPhail teaching multiple page documents in files and a specific method of security involving a pointer.

The suggestion to combine the references may be found in Dozier, col. 15, lines 8-21, stating, in relevant part: "for example, a service might involve . . . specified access controls (such a security restrictions and access costs" Dozier also teaches access based on the first page of a collection with links to other pages, in a similar manner to that taught by MacPhail. See, Dozier, col. 8, lines 52-66. MacPhail teaches security of access to the files in a more specific teaching.

It would have been obvious to one of ordinary skill in the art to have combined the teachings of multiple document files with security with the teachings of MacPhail to use pointers to identify the security limitations because MacPhail teaches a specific means to implement document security on the same types of scanned electronic documents as those taught in Dozier.

The combination of Dozier and MacPhail teaches a method of providing differentiated access to a collection of information, and teaches a pointer to a collection

of information specifying a first access level from a plurality of access levels, but does not expressly teach printing out a representation of the pointer.

Berger teaches a system for managing printing system memory that includes a security code printed out on a machine readable sheet, with such code limited to certain users with permission to access the printer. See, Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system.

Bergen is combinable with Dozier and MacPhail because they all involve access to documents scanned or otherwise incorporated into an electronic form, with Dozier teaching multiple documents in files and security associated with access to those files, with MacPhail teaching multiple page documents in files and a specific method of security involving a pointer, and with Bergen teaching a security system with a pointer to the documents that may be printed out.

The suggestion to combine the references may be found in Dozier, col. 15, lines 8-21, stating, in relevant part: "for example, a service might involve . . . specified access controls (such a security restrictions and access costs" Dozier also teaches access based on the first page of a collection with links to other pages, in a similar manner to that taught by MacPhail. See, Dozier, col. 8, lines 52-66. MacPhail teaches security of access to the files in a more specific teaching. Bergen adds to the teaching of MacPhail by teaching to print out the security access printer for use by authorized individuals.

It would have been obvious to one of ordinary skill in the art to have combined the teachings of Dozier and MacPhail to use pointers to restrict security in accessing

multiple document files with the teachings of Bergen that the security pointer is printed out as a means of accessing the documents because Dozier and MacPhail teach the internal security system while Bergen teaches a means of user interaction with that system.)

Regarding **dependent claim 34, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein each pointer identifies a directory containing the collection, the directory further containing a file indicating an access level.

(The rejection of claim 33 is incorporated by this reference. In addition, MacPhail teaches that each document is assigned a unique name and a LADN. A LADN is defined in MacPhail as a pointer. See, MacPhail, col. 4, lines 4-42.)

Regarding **dependent claim 35, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein each pointer specifies the access level by identifying a file indicating the access level.

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 4-16, teaching access by security levels. It would have been obvious to one of ordinary skill in the art to have combined the print out of the security authorization with the appropriate designation of a security level.

The suggestion or motivation to indicate an access level is taught in MacPhail, col. 4, lines 4-16, teaching access by security levels, and is taught in Bergen, col. 11, lines 14-19, teaching that the print out of the pointer is for the purpose of limiting users to only those with authorization.)

Regarding **dependent claim 37**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 36, wherein outputting the document comprises printing a paper coversheet.

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code.")

Regarding **dependent claim 39**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 36, wherein the indicium comprises a machine-readable code.

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document including the machine-readable indicium as a "machine readable code.")

Regarding **dependent claim 41, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

A method of providing differentiated access to a collection of information, the method comprising:

generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels;

generating a first machine-readable indicium representing the first pointer;

generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level;

generating a second machine-readable indicium representing the second pointer;

outputting a first document including the first machine-readable indicium;

and

outputting a second document including the second machine-readable indicium.

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the

access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.

MacPhail expressly teaches that multiple pointers may be used. See, MacPhail, col. 4, lines 35-37 teaching that if a document is on one or more folders, then each folder has a pointer of LADN entry in the document relation object. Further, with the teaching of one pointer to one security access, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a second pointer to a second security access, for the obvious and beneficial purpose of allowing multiple security access to the documents.)

Regarding **dependent claim 42**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 41, wherein outputting the first document comprises printing a first paper coversheet and outputting the second document comprises printing a second paper coversheet.

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the

access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 43**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 42, wherein outputting the first document further comprises printing, on the first paper coversheet, a collection identifier that uniquely identifies the collection, and wherein outputting the second document further comprises printing, on the second paper coversheet, the same collection identifier.

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 44**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein the plurality of access levels comprises at least one access level selected from the group consisting of:

administrator;

edit;

delete;

read-only; and

add-only.

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 4-16, teaching access by security levels. It would have been obvious to one of ordinary skill in the art to have combined the print out of the security authorization with the appropriate designation of a security level.

The suggestion or motivation to indicate an access level is taught in MacPhail, col. 4, lines 4-16, teaching access by security levels, and is taught in Bergen, col. 11, lines 14-19, teaching that the print out of the pointer is for the purpose of limiting users to only those with authorization.

The Examiner takes official notice of the fact that at the time of the invention method steps that limit access to computer files by users or user groups commonly divide the groups into access rights defined as one or more of "administrator; edit; delete; read-only; and add-only," because that set or rights, including reasonable combinations of such rights, defines the set of common and well known actions which may be effected upon an electronic document.

It would have been obvious to one of ordinary skill in the art at the time of the invention to define access rights as comprising one, more, or a combination of the following: "administrator; edit; delete; read-only; and add-only," for purposes of fully describing the extent of routine electronic data manipulation.

Further, it is noted that levels of access to an electronic document which are described as: "administrator; edit; delete; read-only; and add-only," are implicit in a reference that describes limits to security access to an electronic document. "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). See also, MPEP 2144.01.

MacPhail expressly teaches that multiple pointers may be used. See, MacPhail, col. 4, lines 35-37 teaching that if a document is on one or more folders, then each folder has a pointer of LADN entry in the document relation object. Further, with the teaching of one pointer to one security access, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a second pointer to a second security access, for the obvious and beneficial purpose of allowing multiple security access to the documents.)

Regarding **dependent claim 45**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein the plurality of access levels comprises at least one access level specifying that access permissions should be inherited from a containing collection.

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 7-8, teaching that a security level may be associated with a document as it is filed.)

Regarding **dependent claim 46**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein the plurality of access levels comprises at least one access level specifying that access permissions should be applied to documents within a containing collection.

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching “clipped” documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a “paper-clip.”)

Regarding **dependent claim 47**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein the collection comprises a plurality of documents.

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching “clipped” documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a “paper-clip.”)

Regarding **dependent claim 48**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein the collection comprises at least one multimedia item.

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching “clipped” documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a “paper-clip.” See also, Chen, col. 4, lines 6-19, teaching the storage of a variety of file types, including multimedia items, e.g.: “JPEG.”)

Regarding **dependent claim 49**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein the collection comprises at least one item selected from the group consisting of:

documents;

images;

files;

video data; and

audio data.

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching “clipped” documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a “paper-clip.” See also, Chen, col. 4, lines 6-19, teaching the storage of a variety of file types, including multimedia items, e.g.: “JPEG” which is commonly uses to store an image.)

Regarding **dependent claim 50, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, further comprising:

receiving the representation of one of the first or second pointers;

reading the representation; and

*providing access to the collection, according to the access level specified
by the received pointer representation.*

(Claim 50 incorporates substantially similar subject matter as claimed in claim 35, and is rejected along the same rationale.)

Regarding **dependent claim 51, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, further comprising:

*receiving the representation of one of the first or second pointers;
reading the representation;
receiving a signal indicating a request for access to the collection; and
responsive to the requested access conforming with the access level
specified by the received pointer representation, providing the requested access.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, teaching retrieval of the document.)

Regarding **dependent claim 52, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising:
receiving the representation of one of the first or second pointers;
reading the representation;
receiving a signal indicating a request for access to the collection; and
responsive to the requested access not conforming with the access level
specified by the received pointer representation, denying the request for access.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, Bergen, col. 10, lines 21-29, teaching denial of a security request.)

Regarding **dependent claim 53**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, wherein the representation further indicates at least one criterion for changing the access level.

(The rejection of claim 33 is incorporated by this reference. In addition, see, Bergen, col. 10, lines 21-29, teaching denial of a security request, and that such denial process includes a prompt for a valid security code.)

Regarding **dependent claim 54**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 53, wherein the criterion for changing the access level comprises an expiry criterion.

(The rejection of claim 33 is incorporated by this reference. In addition, see, Bergen, col. 10, lines 21-29, teaching denial of a security request, and that when the opportunities for entering the code have been exhausted, the program exits.)

Regarding **dependent claim 55**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 33, further comprising outputting a collection identifier that uniquely identifies the collection.

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 4-16, teaching that the documents are each assigned a unique identifier.

See also, Bergen, Figure 11, teaching that the target document code is printed out, which in the combination of the inventions of MacPhail and Bergen, would be the unique identifier.)

Regarding **independent claim 56**, Dozier in view of MacPhail and further in view of Bergen teaches:

A method of providing differentiated access to a collection of information, the method comprising:

receiving a first document comprising a first machine-readable indicium representing a first pointer to a collection of information, the first pointer specifying a first access level for accessing the collection;

generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level;

generating a second machine-readable indicium representing the second pointer;
and

outputting a second document including the second machine-readable indicium.

(Claim 56 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

Regarding **independent claim 57, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

A method of providing differentiated access to a collection of information, the method comprising:

receiving a selection of a first access level for a first recipient from a plurality of access levels;

receiving a selection of a second access level, different from the first access level, for a second recipient from a plurality of access levels;
generating a first machine-readable indicium pointing to a collection of information, the first indicium further indicating the first access level;
generating a second machine-readable indicium pointing to the same collection of information, the second indicium further indicating the second access level;
outputting a first document including the generated first machine-readable indicium; and
outputting a second document including the generated second machine-readable indicium.

(Claim 57 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

Regarding **dependent claim 58**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 57, wherein each machine-readable indicium corresponds to a collection identifier.

(Claim 58 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

Regarding **independent claim 59, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

A method of providing differentiated access to a collection of information, the collection comprising a plurality of items, the method comprising:

receiving a selection of a first access level for a first subset of items in the collection;

receiving a selection of a second access level, different from the first access level, for a second subset of items in the collection;

generating a machine-readable indicium pointing to the collection, the indicium further indicating the first access level for the first subset of items and the second access level for the second subset of items; and

outputting a document including the generated machine-readable indicium.

(Claim 59 incorporates substantially similar subject matter as claimed in claim 41 and, in further view of the following, is rejected along the same rationale. It is noted that a collection is, by definition, comprised of a plurality of items. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code.)

Regarding **dependent claim 60**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 59, further comprising generating a collection overview representing the collection, wherein the first access level is associated with a first region within the collection overview, and wherein the second access level is associated with a second region within the collection overview.

(Claim 59 incorporates substantially similar subject matter as claimed in claim 41 and, in further view of the following, is rejected along the same rationale. It is noted that a collection is, by definition, comprised of a plurality of items. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a “machine readable code.” See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code.)

Regarding **dependent claim 61**, Dozier in view of MacPhail and further in view of Bergen teaches:

The method of claim 60, wherein each of the regions within the collection overview contains at least one item.

(Claim 59 incorporates substantially similar subject matter as claimed in claim 41 and, in further view of the following, is rejected along the same rationale. It is noted that a collection is, by definition, comprised of a plurality of items. In addition, see Bergen, col.

9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Note that Bergen, Figure 11, step 208, tests for the existence of a target document, without which no pointer is assigned to be printed out.)

Regarding **independent claim 62, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

A computer program product for providing differentiated access to a collection of information, the computer program product comprising:

a computer-readable medium; and

computer program code, encoded on the medium, for:

generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels;

generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level; and

outputting a representation of at least one of the pointers.

(Claim 62 incorporates substantially similar subject matter as claimed in claim 33 and is rejected along the same rationale.)

Regarding **independent claim 63, as amended**, Dozier in view of MacPhail and further in view of Bergen teaches:

A system for providing differentiated access to a collection of information, comprising:

- a first pointer to a collection of information, the first pointer specifying a first access level from a plurality of access levels;*
- a second pointer to the collection, the second pointer specifying a second access level different from the first access level; and*
- an output device, for outputting a representation of at least one of the pointers.*

(Claim 63 incorporates substantially similar subject matter as claimed in claim 33 and is rejected along the same rationale.)

Regarding **independent claim 64**, Dozier in view of MacPhail and further in view of Bergen teaches:

A file for specifying access levels, comprising:

- at least two resource identifier paths; and*
- for each of the resource identifier paths, an indication of access rights;*
- wherein the access rights for a first resource identifier path differ from the access rights for a second resource identifier path pointing to the same resource.*

(Claim 64 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.

MacPhail expressly teaches that multiple pointers may be used. See, MacPhail, col. 4, lines 35-37 teaching that if a document is on one or more folders, then each folder has a pointer of LADN entry in the document relation object. Further, with the teaching of one pointer to one security access, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a second pointer to a second security access, for the obvious and beneficial purpose of allowing multiple security access to the documents.)

Regarding **dependent claim 65**, Dozier in view of MacPhail and further in view of Bergen teaches:

The file of claim 64, further comprising, for at least one of the resource identifier paths:

an indication of a geographic region within a collection representation; and
an indication of access rights for items within the geographic region.

(It is noted that the specification does not discuss the limitation of a "geographic region" and the term will be treated in this Office Action consistent with its ordinary and accepted definition to one of ordinary skill at the time of the invention, which is an area of the earth.

The rejection of claim 41 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 66**, Dozier in view of MacPhail and further in view of Bergen teaches:

The file of claim 64, wherein at least one of the resource identifier paths identifies a collection.

(The rejection of claim 41 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable

code.” See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.

It is noted that the path is the pointer or identifier taught in the prior art and it is inherent that indicating and accessing a collection of documents, as is taught, contains a path within the identifier or pointer identifying the collection by its file name or other file access code.)

Regarding **dependent claim 67**, Dozier in view of MacPhail and further in view of Bergen teaches:

The file of claim 64, further comprising, for at least one of the resource identifier paths, and indication that access rights should be inherited from a containing collection.

(Claim 67 incorporates substantially similar subject matter as claimed in claim 64 and, in further consideration of the following, is rejected along the same rationale. See also, Chen, col. 1, lines 44-61, teaching that security authorization may be set at the document containing collection level.)

4. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to

be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Response to Arguments

11. Applicants' arguments filed 10/30/07 have been fully considered, but they are not persuasive.

Applicant argues on page 17 of the amendment that amendments made to independent claim 1 are not disclosed or suggested by the cited references considered alone or in the combination proposed by the Examiner. More specifically, applicant argues that the phrase '***selecting at least one action responsive to the order***' provides a mechanism by which a user can specify what action should be taken on a document collection simply through providing a stack of paper documents in a particular order, and doing nothing more. The Examiner disagrees with applicant based upon the language of the claim. The examiner believes the limitation, as presently claimed, fails to preclude a user at an electronic user interface from selecting one action from a group of actions based upon the order of documents scanned into a scanner. As presently claimed, the actions could be interpreted as two separate events. First, a plurality of documents are received in an order (no mention in the claims describes what kind of an order is used). Responsive to the order of documents selecting one action from a group of actions. The rejection under 35 U.S.C. 103(a) as being unpatentable over Dozier in view of Bell still stand because (See, Dozier, Figure 7, and col. 3, line 41 through col. 4,

line 43, teaching the input and storage and manipulation of electronic documents and that the documents may be ordered). The reference fails to explicitly state the retrieval of paper document in an order, however, the Bell reference discloses a method for submitting paper documents using a printer/scanner which scans the electronic paper interface and document into an electronic format. This information is submitted to enhanced barcode server. The content is appropriately stored in the electronic market by storing the digitized interface subject matter into rights database and the content into merchandise database of the server system hosting electronic market (compare to ***"receiving a plurality of paper documents in an order and performing at least one action to cause a change to a stored document collection responsive to the order of the documents"***). See page 6, [0071]. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dozier and Bell before them at the time the invention was made, to modify the document authoring methods taught by Dozier to include the scanning methods of Bell, because it would have provided an additional way to add document to the collection and browse document collections. The newly formed language states ***'determining the order of the plurality of paper documents'***. The language fails to accurately point out who/what is determining the order of the paper documents and what kind of order is used in the system. Therefore, without such language that would sufficiently identify the functions of the terms the references to Dozier in view of Bell still provide a generic order of documents through the scanning of a paper along with a separate paper that contains the usage permissions of the document. Based on this order the user could determine (using the

methods taught by Dozier) what action to perform based upon the order of the 1st and 2nd documents scanned in by the user. The phrase '**determining an order**' fails to overcome the references to Dozier in view of Bell. Independent claim 4 recites similar language to that of claim 1 and therefore the arguments presented above apply to independent claim 4. In reference to independent claim 4, applicant presents a similar argument regarding the order of documents and how the selection is performed responsive to said order. The Examiner would like to point out that without a statement defining who/what/how the performing is being done, the claim limitation fails to preclude the Examiner from utilizing a user interface for selecting one action responsive to the order. Finally, regarding independent claim 4, applicant states the claimed method automatically selects the desired action based on the order of the documents by determining the presence or absence of indicium on each of the document. The language present in this argument fails to clearly represent an argument based upon the language found in the independent claim.

Applicant argues on pages 27-29 of the amendment that a hypertext link and the indicium in claimed invention are two different concepts. The indicium is a physical marking on a piece of paper and it identifies a collection of one or more groups of electronic documents or media. As presently claimed, there is no description of the indicium and it is unclear to the Examiner, other than the indicium being a mark on a document identifying a collection, what exactly the function of the indicium is. Therefore, the primary reference to Dozier provides a generic description of a mark on a document (See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and

subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the documents to an existing or new collection).

Regarding independent claim 18 and the arguments presented on pages 25, applicant states Chen fails to disclose or suggest adding an annotation to an electronic collection, nor does it disclose or suggest reading a collection identifier from a paper item. Furthermore, applicant states the Bell reference does not remedy the deficiencies. However, the Examiner would like to remind the applicant that claims are to read broadly in light of the specification and as such, the Examiners interpretation of 'collection of information', as presently claimed, could be a database. If the information contained in a scanned document using a request from a user than it suggests an identifier presented in the metadata and a database (collection of information) is utilized to store data and retrieve data based upon the annotations and/or document identifier. The secondary reference to Bell provides the paper document using a printer/ scanner which scans the electronic paper interface and document into an electronic format. This method would have provided an additional way to add documents to the collection and browse document collections based upon annotated media items.

Regarding independent claim 33, applicant states that claim 33 recites a method providing a mechanism for enabling a first access level for users having a first machine-readable indicium and a second, different access level for users having a second machine-readable indicium. The Examiner does not agree with applicant's statement

that the above-mentioned language is recited in the claim. Independent claim 33 recites 'generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels. (It is noted that the application discloses a "pointer" as follows: *"Each collection has a specific, unique address or identifier, such as a uniform resource locator (URL), which provides a pointer to the collection. References herein to a pointer, collection identifier, or distributed resource identifier (DRI) can be considered to refer to a URL or any other mechanism, tag, handle, pointer, or technique for identifying a file, collection, directory, or other group of files."* See, disclosure, paragraph [0053].

Dozier teaches a method of providing differentiated access to a collection of information, but does not expressly teach a pointer to a collection of information specifying a first access level from a plurality of access levels. MacPhail teaches a pointer, or "LADN entry," to a security level associated with a document for the purpose of restricting access and users of the document. See, MacPhail, col. 4, lines 4-65, teaching the pointer and security levels.

Dozier and MacPhail are a proficient combination because they both involve access to documents scanned or otherwise incorporated into an electronic form, with Dozier teaching multiple documents in files and security associated with access to those files, and with MacPhail teaching multiple page documents in files and a specific method of security involving a pointer. Applicant is reminded that arguments presented should be based upon the language, as presently claimed. When applicant argues aspects of the invention instead of focusing on the limitations of the claims, it leaves the

Examiner no choice but to restate the arguments presented in the previous rejection.

The newly added claim language within independent claim 33 provides access privileges for a first level and second level regarding a collection of information. Dozier provides administrative tasks, such as setting access controls (i.e. costs and security privileges), for collections. The reference provides the basis or suggestion of priority access. The examiner disagrees with the applicant and points to the MacPhail reference, column 4, lines 4-65, which provides 'LADN entry' to a security level associated with a document for the purpose of restricting access and users of the document. The reference suggests access privileges and would have limited access to document collections through the use of access restrictions.


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML



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